

ESTTA Tracking number: **ESTTA752622**

Filing date: **06/15/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Skullcandy, Inc.
Granted to Date of previous extension	06/15/2016
Address	1441 W. Ute Blvd, Suite 250 Park City, UT 84098 UNITED STATES
Attorney information	Christopher M. Dolan BARNES & THORNBURG One North Wacker Drive, Suite 4400 Chicago, IL 60606 UNITED STATES trademarks-ch@btlaw.com, cdolan@btlaw.com, mballesteros@btlaw.com, Inolan@btlaw.com Phone:312.357.1313

Applicant Information

Application No	86714576	Publication date	02/16/2016
Opposition Filing Date	06/15/2016	Opposition Period Ends	06/15/2016
Applicant	HEADBALL RECORDS LLC Unit 1906 Aventura, FL 33180 UNITED STATES		

Goods/Services Affected by Opposition


<p>Class 009. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Pre-recorded records, compact discs, DVDs and audio/visual discs, all featuring music; musical sound recordings; audiovisual recordings featuring music and musical based entertainment; downloadable musical sound and downloadable audiovisual recordings featuring music and musical based entertainment; sound recordings featuring music; video recordings featuring music; digital music downloadable from the Internet; video recordings featuring musical artists; audio recordings featuring music</p>
<p>Class 041. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Entertainment services in the nature of providing information relating to music and entertainment via a global computer network; providing on-line entertainment, namely, providing non-downloadable sound and audiovisual recordings in the field of music and musical based entertainment; providing a website over a global computer network featuring information on musical artists; providing information about performances to be given by musical artists on tours; production of sound recordings; providing information about popular culture and events and musical based entertainment; production of music; production and publishing of music; fanclubs; audio and sound recording and production; record production; entertainment services, namely, production of music concerts before live audiences; entertainment services, namely, provid-</p>

ing a website featuring musical performances, non-downloadable musical videos, related film clips, and photographs; entertainment services, namely, providing on-line non-downloadable articles on musical artists and music videos; entertainment services, namely, providing prerecorded music, information in the field of music, and articles about music, all on-line via a global computer network and non-downloadable; entertainment services in the nature of recording, production and post-production services in the field of music; Production of sound recordings; Production of musical sound recordings; Entertainment services in the nature of presenting live musical performances


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3168754	Application Date	02/07/2006
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/01/12 First Use In Commerce: 2003/01/12 Devices for hands-free use of mobile phones; Digital audio players; Digital phones; Earphones; Headphones; MP3 players; Portable listening devices, namely, MP3 players; Portable media players; Protective helmets; Protective helmets for sports; Sports helmets		

U.S. Registration No.	4622095	Application Date	12/28/2012
Registration Date	10/14/2014	Foreign Priority Date	NONE


Word Mark	NONE
Design Mark	
Description of Mark	The mark consists of a stylized skull.
Goods/Services	<p>Class 009. First use: First Use: 2005/04/15 First Use In Commerce: 2005/04/15 Audio speakers; portable speakers; speaker docks; dock speakers for mobile audio players; headsets for use with computers; audio equipment for use in connection with helmets, namely, speakers, headphones, earphones, and microphones that can be attached to or integrated into a helmet; cases for mobile phones and cell phones</p> <p>Class 025. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Clothing, namely, jackets; outerwear, namely, coats, sweatshirts; socks; footwear</p> <p>Class 028. First use: First Use: 2012/09/13 First Use In Commerce: 2012/09/13 Headsets for use with game consoles and video games; audio and visual headsets for use in playing video games; gaming headsets adapted for use in playing videogames</p> <p>Class 042. First use: First Use: 2012/09/17 First Use In Commerce: 2012/09/17 Custom design of products based on personal selections made by consumers, namely, devices for hands-free use of mobile phones, earphones, headphones, portable speakers, headsets for use with computers, game consoles and video games; custom design of products, namely, devices for hands-free use of mobile phones, earphones, headphones, portable speakers, headsets for use with computers, game consoles and video games based on personal selections made by consumers through the temporary use of a web-based software application</p>
Attachments	<p>78809362#TMSN.png(bytes) 85982661#TMSN.png(bytes) 86714576 - Notice of Opposition.pdf(93866 bytes) 86714576 - EXHIBIT A.pdf(1273885 bytes)</p>

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Christopher M. Dolan/
Name	Christopher M. Dolan
Date	06/15/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Skullcandy, Inc., Opposer, v. Headball Records LLC, Applicant.	Opposition No.: _____ Mark:  U.S. Serial No.: 86/714,576
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NOTICE OF OPPOSITION

Opposer, Skullcandy, Inc. (“Opposer”), a Delaware corporation with its principal place of business at 1441 Ute Blvd. Park City, Suite 250, Utah 84098, believes that it will be damaged by registration of the design mark that is the subject of United States Trademark Application Serial No. 86/714,576 (“Opposed Mark”), filed in the name of Headball Records LLC (“Applicant”), a Florida Limited Liability Company, with an address of 21050 Point Place, Unit 1906, Aventura, Florida 33433-3487, and therefore, hereby opposes such registration of the application pursuant to 15 U.S.C. § 1063. In support of its opposition, Opposer states as follows:


1. Since prior to the filing date of Applicant’s intent to use application for registration of the Opposed Mark, Opposer has continuously and extensively used, in interstate commerce throughout the United States, the Skull design mark pictured below (“Skull Logo”) on and in connection with the advertising, promotion, offer and sale of various goods and services, including without limitation headsets, headphones, ear buds, earphones, portable speakers, musical sound recordings, audiovisual recordings featuring music, downloadable music and audiovisual recordings featuring music, video recordings featuring music and musical artists,


digital music downloadable via the Internet and mobile applications; entertainment services, including providing information relating to music, music artists, music events and entertainment via the Internet and mobile applications, production and publishing of music and sound recordings, production of festivals and concerts and non-downloadable musical videos (“Opposer’s Goods and Services”).



2. Opposer has invested considerable money, time and effort into the use, advertising, and promotion of the Skull Logo for use in connection with Opposer’s Goods and Services. As a result of Opposer’s extensive investment in the Skull Logo, Opposer owns strong common law rights in the Skull Logo, embodying very valuable goodwill, and the Skull Logo has become famous in the United States.

3. In addition to its common law rights, Opposer owns, among others, the following federal trademark registrations for the Skull Logo:

Mark	Reg. No.	Reg. Date	Goods
	3,168,754	Nov. 7, 2006	Class 9: Devices for hands-free use of mobile phones; digital audio players; digital phones; earphones; headphones; mp3 players; portable listening devices, namely, mp3 players; portable media players; protective helmets; protective helmets for sports; sports helmets

Mark	Reg. No.	Reg. Date	Goods
	4,622,095	Oct.14, 2014	Class 9: Audio speakers; portable speakers; speaker docks; dock speakers for mobile audio players; headsets for use with computers; audio equipment for use in connection with helmets, namely, speakers, headphones, earphones, and microphones that can be attached to or integrated into a helmet; cases for mobile phones and cell phones

4. Copies of the certificates of registration for Registration Nos. 3,168,754 and 4,622,095 are attached as Exhibit A. These federal registrations are valid, subsisting and in full force and effect. Registration No. 3,168,754 is incontestable pursuant to 15 U.S.C. § 1065, and is conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce in connection with the goods referenced in the registration.

5. Notwithstanding Opposer's prior rights in and to the Skull Logo, Applicant filed, on August 4, 2015, an application to register the design mark below for various music-related goods and services in International Classes 9 and 41.



6. The Opposed Mark is confusingly similar, in appearance and commercial impression, to Opposer's Skull Logo. The registration and use of the Opposed Mark by Applicant in association with the applied-for goods and services is likely to cause confusion as to the source or origin of Applicant's goods and services, and is likely to mislead consumers, all to Opposer's damage.

7. The goods and services that Opposer provides under the Skull Logo, and the goods and services for which its Skull Logo is registered, are identical and, at a minimum, closely related, to the goods and services listed in Application Serial No. 86/714,576. Upon information and belief, Opposer's Goods and Services and Applicant's applied-for goods and services are offered to the same, similar or overlapping classes of purchasers.

8. The Opposed Mark, when used in connection with Applicant's applied-for goods, is likely to cause confusion, to cause mistake, and to deceive the trade and public, who, upon seeing the Opposed Mark in connection with Applicant's applied-for goods and services, would believe that such goods and services originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with Opposer. Accordingly, registration of the Opposed Mark would damage Opposer, and registration, therefore, should be refused pursuant to 15 U.S.C. §1052(d).

9. The Opposed Mark, when used in connection with Applicant's applied-for goods and services, is likely to cause dilution of Opposer's famous Skull Logo, by lessening the capacity of the Skull Logo to identify and distinguish Opposer's Goods and Services and by harming the reputation of the Skull Logo, all to Opposer's detriment. Opposer's Skull Logo was famous prior to the filing date of the subject application. Accordingly, registration of the Opposed Mark should be refused based on a likelihood of dilution by blurring and tarnishment, pursuant to 15 U.S.C. §1125(c).

WHEREFORE, Opposer believes that it will be damaged by registration of the mark which is the subject of United States Trademark Application Serial No. 86/714,576 and therefore, respectfully requests that such registration be refused.

The Director hereby is authorized to charge the filing fee for this Notice of Opposition to Deposit Account No. 12-0913.

Respectfully submitted,

SKULLCANDY, INC.

Dated: June 15, 2016

By: /Christopher M. Dolan/
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Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION and Exhibit A thereto was served on counsel for Applicant at the following address by U.S. mail, postage prepaid on this 15th day of June 2016.

Daniel S Polley P A
7251 W Palmetto Park Rd Ste 202
Boca Raton, FL 33433-3487

/Christopher M. Dolan/

Exhibit A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 3,168,754

United States Patent and Trademark Office

Registered Nov. 7, 2006

**TRADEMARK
PRINCIPAL REGISTER**



SKULLCANDY, INC. (UTAH CORPORATION)
SUITE 301
1910 PROSPECTOR AVENUE
PARK CITY, UT 84060

PLAYERS; PROTECTIVE HELMETS; PROTECTIVE
HELMETS FOR SPORTS; SPORTS HELMETS, IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FOR: DEVICES FOR HANDS-FREE USE OF MO-
BILE PHONES; DIGITAL AUDIO PLAYERS; DIGI-
TAL PHONES; EARPHONES; HEADPHONES; MP3
PLAYERS; PORTABLE LISTENING DEVICES,
NAMELY, MP3 PLAYERS; PORTABLE MEDIA

FIRST USE 1-12-2003; IN COMMERCE 1-12-2003.

SER. NO. 78-809,362, FILED 2-7-2006.

JERI J. FICKES, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office



Reg. No. 4,622,095

Registered Oct. 14, 2014

Int. Cls.: 9, 25, 28, and 42

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

SKULLCANDY, INC. (DELAWARE CORPORATION)
1441 W. UTE BLVD, SUITE 250
PARK CITY, UT 84098

FOR: AUDIO SPEAKERS; PORTABLE SPEAKERS; SPEAKER DOCKS; DOCK SPEAKERS FOR MOBILE AUDIO PLAYERS; HEADSETS FOR USE WITH COMPUTERS; AUDIO EQUIPMENT FOR USE IN CONNECTION WITH HELMETS, NAMELY, SPEAKERS, HEADPHONES, EARPHONES, AND MICROPHONES THAT CAN BE ATTACHED TO OR INTEGRATED INTO A HELMET; CASES FOR MOBILE PHONES AND CELL PHONES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 4-15-2005; IN COMMERCE 4-15-2005.

FOR: CLOTHING, NAMELY, JACKETS; OUTERWEAR, NAMELY, COATS, SWEATSHIRTS; SOCKS; FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-1-2004; IN COMMERCE 1-1-2004.

FOR: HEADSETS FOR USE WITH GAME CONSOLES AND VIDEO GAMES; AUDIO AND VISUAL HEADSETS FOR USE IN PLAYING VIDEO GAMES; GAMING HEADSETS ADAPTED FOR USE IN PLAYING VIDEO GAMES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 9-13-2012; IN COMMERCE 9-13-2012.

FOR: CUSTOM DESIGN OF PRODUCTS BASED ON PERSONAL SELECTIONS MADE BY CONSUMERS, NAMELY, DEVICES FOR HANDS-FREE USE OF MOBILE PHONES, EARPHONES, HEADPHONES, PORTABLE SPEAKERS, HEADSETS FOR USE WITH COMPUTERS, GAME CONSOLES AND VIDEO GAMES; CUSTOM DESIGN OF PRODUCTS, NAMELY, DEVICES FOR HANDS-FREE USE OF MOBILE PHONES, EARPHONES, HEADPHONES, PORTABLE SPEAKERS, HEADSETS FOR USE WITH COMPUTERS, GAME CONSOLES AND VIDEO GAMES BASED ON PERSONAL SELECTIONS MADE BY CONSUMERS THROUGH THE TEMPORARY USE OF A WEB-BASED SOFTWARE APPLICATION, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 9-17-2012; IN COMMERCE 9-17-2012.

OWNER OF U.S. REG. NOS. 3,168,754, 3,871,064, AND OTHERS.



Michelle K. Lee
Deputy Director of the United States
Patent and Trademark Office

Reg. No. 4,622,095 THE MARK CONSISTS OF A STYLIZED SKULL.

SN 85-982,661, FILED 12-28-2012.

TARAH HARDY, EXAMINING ATTORNEY